

REMARKS

The Office Action dated February 17, 2005 has been carefully considered. In the Office Action, claims 14-25 were withdrawn from consideration as being drawn to the non-elected invention. Applicant herewith affirms election as to Group I claims, claims 1-13 and 26-27. In further response to the restriction requirement, Claims 14-25 being drawn to the non-elected invention have been canceled without prejudice as Applicant reserves the right to prosecute those claims in divisional applications. Claims 26-27 also have been cancelled without prejudice. Claims 1-13 remain pending in this application. Applicant respectfully requests reconsideration and re-examination in view of the foregoing amendments and the following remarks.

As a preliminary matter, a new Power of Attorney form and Correspondence Address Change is made of record with this Amendment. Applicant asks that this be acknowledged by way of the next communication from the Patent Office.

First as it pertains to the last issue, namely the double patenting in paragraph 11 of the Office Action, Applicant has simply canceled claims 26 and 27 without prejudice.

Turning to the primary issue raised then, the Examiner has rejected claims 1-9, 12, and 13 as being obvious over Gebka as set forth in paragraph 8 of the Office Action. The Office Action acknowledges that Gebka does not include a friction coating on the label as is claimed. However, the Office Action at page 4 asserts that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to put the friction coating on the label instead of the holder because it has been held that a mere

reversal of the essential working parts of a device involves only routine skill in the art [citing *In re Einstein*, 8 USPQ 167]." This rejection is traversed for a number of reasons including that Applicant's invention is not a mere reversal of parts and furthermore, that there is no motivation or suggestion cited in the Office Action as a basis to assert a prima-facie case of obviousness as is required under MPEP § 2143 and 2143.01.

First, Applicant's invention is not a mere reversal of the components or parts of Gebka. In particular, Gebka discloses a high friction coating by utilizing a different plastic material for the extruded ribs of a plastic price channel by way of an co-extrusion process. Indeed Gebka discloses that "generally the price channel itself is an extrusion of a somewhat hard PVC and the ribs or coating on the ribs may be a co-extrusion of a softer PVC." See column 1, lines 45-50. Gebka only teaches a plastic material extrusion typical of PVC or polymer material as the means to provide the higher friction plastic ribs, nothing more.

Applicant's disclosure does not pertain to extruded soft PVC material on the face stock of a conventional label material. Instead, Applicant's disclosure pertains to the use of a weak adhesive (See e.g. claims 6-8 and 13 for example which affirmatively claims a weak adhesive which clearly is not the same as an extruded PVC rib). Applicant's disclosure is clearly different than a co-extruded soft PVC material of that discussed in Gebka. Thus, Applicant's invention does not pertain to a mere reversal of parts but is a substantially different concept. With this in mind, there is no evidence set forth in the Office Action that it is even possible or practical to co-extrude soft PVC material ribs with conventional label stock material thus, the Office Action has also failed to establish

a reasonable expectation of success under MPEP § 2143.02. Indeed, forming PVC ribs 18 such as that taught on Gebka onto a sheet of labels even if it were possible would seem counter-intuitive. In particular, it is desirable to have substantially flat planer labeling material for the purposes of printing, die cutting and handling as set forth in paragraph 23 of Applicant's present disclosure. Thus, there would be a disincentive for making the asserted modification since these activities desire substantial flat material. In short, Applicant's invention is not merely a reversal of components parts because Applicant's disclosure does pertain to co-extruding soft PVC material on the back of labels. Furthermore, it is noted that Applicant specifically claims a weak adhesive in claims 6-8 and 13 which clearly is not discussed or taught in Gebka such that it can be clear that it is not merely a reversal of component parts as applied to these claims.

Additionally, the Examiner's identification of an old case that held the mere reversal of essential working parts of a device involves only routine skill in the art has been applied only where the same exact parts have been replaced which is not present here as evident from the preceding paragraph. Moreover, the Office Action has failed to establish a motivation or reason for the worker in the art without the benefit of the Applicant's specification to make the necessary changes in the referenced device. In particular, the Board has held in the more recent case of *Ex parte Chicago Rawhide Manufacturing Company* 223 USPQ 351 (1984) that the prior art must provide the teaching or motivation for the asserted rearrangement:

"the mere fact that a worker in the art could rearrange the parts of the reference to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a

motivation or reason for the worker in the art, without the benefit of Appellant's specification, to make the necessary changes in the referenced device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the [prior art] device to render the here claimed device unpatentable."

Here, in reviewing the Office Action, there is no evidence to support the conclusion that a worker in this art would have had a motivation to make the necessary changes in the Gebka reference. In fact, Applicant has pointed to significant distinctions between a label holder plastic extrusion as opposed to a labeling sheet with a coating of friction material which is not conventionally a plastic co-extrusion. Thus, not only does the Office Action fail to cite any reasons or motivation in the prior art itself, but it would further appear that the only motivation or reason for making the asserted obviousness rejection comes from Applicant's disclosure itself which is the first in advancing the state of art to provide for such a label with a friction coating as applied to a specific label holder application as claimed in claim 1. Thus, it further appears that the rejection has been made with the improper assistance of hindsight. For these reasons, Applicant respectfully requests that the obviousness rejections be withdrawn.

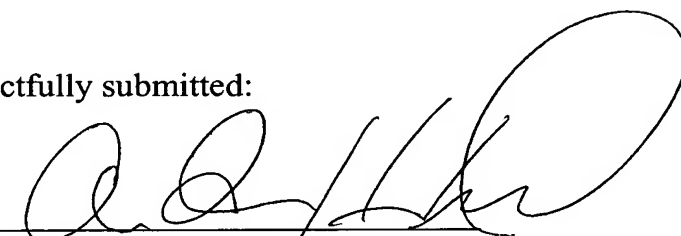
It is further noted that obviousness rejections are presented in paragraphs 9 and 10 of the Office Action as it pertains to certain dependent claims. However, the secondary references cited in paragraphs 9 and 10 do not cure the based deficiencies of the Gebka reference or the asserted obviousness rejection. Accordingly, the teachings of a whole of these references do not provide a basis for a prima-facie obviousness rejection. Removal of these obviousness rejections are therefore also solicited at least for these reasons.

CONCLUSION

In summary, claims 1-13 are believed to be allowable for the reasons given herein. Accordingly, these claims remain pending following entry of this Amendment, and are believed to be in condition for allowance at this time. As such, Applicant respectfully requests entry of the present Amendment and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicant's undersigned representative at the number listed below.

Respectfully submitted:

BY

A large, stylized handwritten signature in black ink, likely belonging to Andrew J. Heinisch, is written over a horizontal line.

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